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08/413,136 03/29/95 KENPF

D. 4681 US 1034

EXAMINER

TRAVERS, R

ART UNIT

PAPER NUMBER

6

12M2/0402

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DATE MAILED:

04/02/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 3/29/95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 27-31 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 27-31 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

The preliminary amendment filed March 29, 1995 has been received and entered into the file.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 29-31 are rejected under the judicially created doctrine of double patenting. This non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy, this policy reflected in 35 USC 101, so as to prevent the unjustified or improper timewise extension of the right to exclude, granted by patent. *In re Starett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re White*, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (CAFC 1985); *In re Goodman*, 29 USPQ2d 2010 (CAFC 1993).

The subject matter recited in claims 29-31 of the instant Application is fully disclosed in United States Patent No. 5,142,056. Allowance of pending claims 29-31 would extend the rights to exclude, already granted in United States Patent No. 5,142,056. If allowed, the instant claims 29-31, not only would

provide patent protection to the subject matter of pending claims 29-31, but also extend patent coverage to the subject matter already disclosed in patent 5,142,056. Thus, the controlling fact is that patent protection for the composition, fully disclosed in and covered by the claims of patent 5,142,056, would be extended by the allowance of claims 29-31, pending in the instant application.

Furthermore, there is no apparent reason why Applicants were prevented from presenting the instant pending claims for examination during the prosecution of the issued patent.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) would overcome an actual or provisional rejection on a non-statutory double patenting ground, providing the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

No claims are allowed.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.



Russell Travers
Primary Examiner
Art Unit 1205